

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following arguments is respectfully requested.

Claims 13-30 have been deleted without prejudice or disclaimer. New claims 31-34 have been added. No new matter has been added as a result of the addition of these new claims. Additionally, no additional claim fees are believed to be due and owing as a result of the addition of these claims.

Claim Rejections – 35 U.S.C. Section 112

Claims 13-30 are rejected under 35 U.S.C. Section 112, first paragraph as not being described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 13-30 have been deleted. However, Applicant will now address this rejection with respect to new claims 31-34.

An analysis of whether a claim is enabled by the specification in an application requires a determination of whether the specification, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. Enablement is not precluded by the necessity for some experimentation provided that the experimentation needed to practice the invention is not undue. The key word is “undue” not experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Moreover, the test of undue experimentation is “not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine...” *Id.*

The Office Action goes on to examine enablement in view of three (3) of the *Wands* factors, namely, the state of the prior art, working examples and the predictability of the art. With respect to the state of the prior art, the Office Action states that at the time the invention was made that there was not much published literature regarding the crossing of *Impatiens flaccida* and *Impatiens Hawkeri*. Applicant would like to point out to the Examiner that the prior art does describe recovery of hybrid seedlings from interspecific crosses using *Impatiens flaccida alba* x *Impatiens repens* and *Impatiens uguenensis* x *Impatiens flaccida alba*; however, no seedlings were recovered from crosses of *Impatiens flaccida alba* x *Impatiens herzogii*, *Impatiens flaccida alba* x *Impatiens epiphytica*, or *Impatiens flaccida alba* x *Impatiens hookeriana* (T. Arisumi, *J. Amer. Soc. Hort. Sci.* 105(5): 629-631 (1980)). An additional study confirmed the previous *Impatiens flaccida alba* x *Impatiens repens* and *Impatiens uguenensis* x *Impatiens flaccida alba* successes, while no seedlings were recovered from a cross between *Impatiens flaccida alba* x ‘*Pele*’, a New Guinea *impatiens* cultivar (T. Arisumi, *J. Amer. Soc. Hort. Sci.* 110(2): 273-276 (1985)). An article by Arisumi (see T. Arisumi, *J. Amer. Soc. Hort. Sci.*, 112(6):1026-1031 (1987)) describes interspecific hybrids resulting from a

cross between *Impatiens flaccida* and *Impatiens Wallerana* 'Elfin White' (*Impatiens sultani* in his publication).

With respect to working examples, the Examiner says that there is only one example of breeding *Impatiens flaccida* and *Impatiens Hawkeri*. Applicant wishes to remind the Examiner that compliance with the enablement requirement does not turn on whether an example is disclosed or, if an example is disclosed, the number of examples. All that Section 112, first paragraph requires is an enabling disclosure; each and every actual embodiment of a claimed invention does not have to be described.

With respect to the predictability of the art, the Office Action says that it is uncertain if one skilled in the art would be able to repeat the same process because the crossing of two species "will not" always have the same outcome as described in the instant application. Applicant submits that this argument is moot in view of new claims 31-34.

In addition to the three (3) *Wands* factors discussed in the Office Action, there are a number of other *Wands* factors that must be considered, including, but not limited to, (1) the amount of direction provided by the inventor; (2) the breadth of the claims; (3) the nature of the invention; (4) the level of one of ordinary skill; and (5) the quantity of experimentation need to make or use the invention based upon the content of the disclosure. The *Manual of Patent Examining Procedure (MPEP)* Section 2164.01 (Rev. 1, Feb. 2003), cautions that "[I]t is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all of the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole." (emphasis added).

Moreover, Section 2164.01 of the *MPEP* goes on to state, "[A] conclusion of a lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation."

The claimed invention relates to methods for producing interspecific *impatiens* seed and plants resulting from the planting and growing said seed. New claim 31 is directed to a method of producing interspecific *impatiens* seed by crossing a first parent *Impatiens flaccida* plant with a second parent *Impatiens Hawkeri* plant and then harvesting the resulting interspecific *impatiens* seed. Claim 32 is directed to the further step of planting the seed resulting from the above-identified cross and growing said seed into an interspecific *impatiens* plant. Claim 33 is directed to a selecting an interspecific plant having a trailing habit. Claim 34 is directed to taking a cutting of said trailing interspecific *impatiens* plant.

The specification, on pages 4-5 and in Examples 1 and 2, provides a sufficient amount of direction by the inventor for one of ordinary skill in the relevant art of plant

breeding to conduct the claimed method. In fact, Applicant respectfully submits that the breath of the claims and the nature of the invention are commensurate with the disclosure in the specification. Additionally, one important factor that must be considered is the level of skill in plant breeding, which is quite high. The method of claimed invention uses routine breeding techniques that are well known to the skilled plant breeder. Moreover, the quantity of experimentation that would be required by one skilled in the art to make the claimed invention would not be excessive and certainly would not be "undue". In fact, as discussed in Applicant's last Response filed on June 16, 2003, the claimed method has been successfully repeated by the Applicant numerous times.

Therefore, in view of the aforementioned arguments and the evidence of record as a whole, Applicants submit that this rejection should be withdrawn.

Claims 13-24 and 26-30 remain rejected under 35 U.S.C. Section 112, first paragraph, as not being described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the reasons stated in paper number 27, pages 2-4. Claims 13-24 and 26-30 have been deleted. Applicant will now address this rejection with respect to new claims 31-34.

As discussed in Applicant's last two Responses, the inquiry into whether the written description requirement is met is determined on a case-by-case basis and is a question of fact. *Manual of Patent Examining Procedure* Section 2163.04 (Eighth Edition, August 2001). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. *Id.* The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. *Id.* The Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Id.*

As discussed above, new claim 31 is directed to a method of producing interspecific *impatiens* seed by crossing a first parent *Impatiens flaccida* plant with a second parent *Impatiens Hawkeri* plant and then harvesting the resulting interspecific *impatiens* seed. Claim 32 is directed to the further step of planting the seed resulting from the above-identified cross and growing said seed into an interspecific *impatiens* plant. Claim 33 is directed to a selecting an interspecific plant having a trailing habit. Claim 34 is directed to taking a cutting of said trailing interspecific *impatiens* plant.

The specification, on pages 4-5 and in Examples 1 and 2, provides a sufficient written description for one of ordinary skill in the relevant art of plant breeding to conduct the claim method. Additionally, as also discussed above, one important factor that must be considered is the level of skill in plant breeding, which is quite high. In fact, because the level of skill in plant breeding is high, Applicant submits that the description on pages 4-5 and in the two (2) examples, sufficiently demonstrates that the inventor had possession of the invention at the time the application was filed.

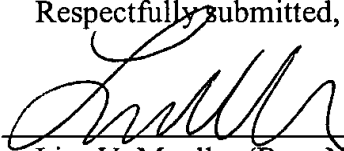
Thereupon, in view of the above arguments, Applicant respectfully submits that the Examiner has not provided a reasonable basis for challenging the adequacy of the written description of the present application. Specifically, the Examiner has not met her burden of providing by a preponderance of the evidence why one of ordinary skill in the art would not recognize that the present disclosure a description of the invention as defined in the claims. Therefore, Applicant submits that this rejection should be withdrawn.

In view of the aforementioned amendments and arguments, Applicant submits that claims 31-34 are now in condition for allowance.

If any additional fees are incurred as a result of the filing of this paper, authorization is given to charge deposit account number 23-0785.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this Amendment is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on a November 24, 2003.

